

## 1. The Objections to Claims 32, 45, and 58

The examiner objects to claims 32, 45, and 58, stating that:

Concerning claims 32, 45 and 58, in the limitations "generating token data depending on said selection data", the term "token" defines coupon offers preferably in coded form, such as bar codes, but the token is not immediately recognized as a coupon per se (although it has coupon data encoded thereon). Subsequently, the token is transmitted to the user or user's computer and the user takes the token to his selected store, encoded on the token, and receives, upon purchasing the required item as encoded on the token, the appropriate purchase incentive or discount or promotion automatically or a voucher, redeemable on a future purchase, may be provided to the user instead and in accordance with the purchase incentive or promotion received from the central computer database and stored in the local store server database (See embodiments of figs. 13 and 18 of the specification). In other words, the token, which can very well be a piece of paper, has data similar to coupon data encoded thereon except for the discount value or the purchase incentive itself that is stored locally at the redemption site or on a remote central repository accessible by the redemption site system. In any event, whether a token or a coupon (e-coupon) is being presented for use, the redemption is virtually or substantially performed the same way, especially if the coupon distribution and redemption are conducted electronically.

Finally, "generating a purchase incentive based. . ." is interpreted as --retrieving the purchase incentive from the local store server in response to the token bearer's or identified user's purchase of the required item as read from the token--. Here, the "purchase incentive" was earlier transmitted from the main computer central repository to the selected local store server database in response to the user's selection.

Appropriate correction is required. [Office action mailed June 29, 2005  
page 3 lines 3-23.]

In response, the applicant traverses the requirement because it is indefinite. The examiner provides what appears to be a claim construction, not identification of an error. Therefore, the applicant respectfully requests that the examiner either (1) specify the error and requirement or (2) remove the requirement.

**2. Double Patenting Rejection of Claims 32, 45, and 58**

The examiner has issued two double patenting rejections of claims 32, 45, and 58, stating that:

Claims 32, 45 and 58 (i.e. 32-70) of the Instant Application are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over at least claims 65 and 67 of co-pending Application Serial No. 09/478,351. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

Claim 32 of the Application substantially recites the limitations of claim 65 of Application Serial No. 09/478, 351, as shown.

32. (Once Amended) A computer implemented method for distributing purchasing incentives to consumers, comprising:

transmitting promotion data identifying a plurality of product discounts from a main computer to a personal computer over a computer network;

displaying said plurality of product discounts at said personal computer based on said promotion data;

transmitting selection data designating at least one product discount selected from said plurality of product discounts from said personal computer to said main computer over said computer network;

generating token data depending on said selection data;  
transmitting said token data from said main computer to  
said personal computer over said computer network;  
identifying said token data in a retail store in association  
with items being purchased at said retail store;  
determining discount items being purchased corresponding  
to said at least one product discount from said identified token  
data; and  
generating a purchase incentive based on said discount  
items.

65. (Twice Amended) A method for distributing purchasing  
incentives to customers, said method comprising [the steps of]:

transmitting a prompt for an electronic [mailing] mail  
address of a customer from a central computer over a computer  
network to a personal computer;

in response to said prompt, transmitting said electronic  
[mailing] mail address over said computer network to said central  
computer;

associating at [the] said central computer the electronic  
[mailing] mail address with a unique customer identification;

transmitting an incentive offer over said computer network  
to said personal computer based on data stored at the central  
computer and associated with the unique customer identification;

transmitting incentive offer selection data over said  
computer network to said central computer; and

in response to said selection data, transmitting data defining  
an incentive token over said computer network to said personal  
computer, wherein said incentive token is exercisable for said

incentive at a store designated by said incentive offer.

As shown above, claim 32 omits the underlined portions of claim 65. However, one skilled in the art would have understood that these underlined portions or limitations are implicitly recited in claim 32. Further, this mailing address (including zip code) is part of the demographic data originally collected from the user during the initial encounter (user's first contact with the system) to decide, for example, whether or not the user lives in a qualified zip code, i.e. a zip code associated with a participating local store, before the user is allowed to receive and select product offers therefrom. In other words, before the user is allowed to select products from the system, as recited in claim 32, he must first provide his mailing address (at least his zip code) and this mailing address can be used at least to transmit the generated token, samples or marketing literature, to the user.

Additionally, it is common practice to collect demographic information including mailing address from a user and use the collected information to send, via the Post Office, promotional information, such as coupons, to the user.

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention to collect demographic information, including mailing address having a defined zip code, from the user during a registration process and use the collected data to decide whether the user lives in a qualified zip code and to mail, subsequent to this determination, a product coupon or a generated token having encoded thereon the user's product offer selections.

This is a provisional obviousness-type double patenting rejection since the conflicting claims have not in fact been patented.

Claims 32, 45 and 58 (i.e. 32-70) of the Instant Application are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7 and 8 of U.S. Patent No. 6,185, 541. Although the conflicting claims are not identical, they are not patentably distinct from each

other.

For example, claim 32 of the Instant Application substantially recites the limitations of claim 8 of the Patent, as shown below.

32. (Once Amended) A computer implemented method for distributing purchasing incentives to consumers, comprising:

transmitting promotion data identifying a plurality of product discounts from a main computer to a personal computer over a computer network;

displaying said plurality of product discounts at said personal computer based on said promotion data;

transmitting selection data designating at least one product discount selected from said plurality of product discounts from said personal computer to said main computer over said computer network;

generating token data depending on said selection data;

transmitting said token data from said main computer to said personal computer over said computer network;

identifying said token data in a retail store in association with items being purchased at said retail store;

determining discount items being purchased corresponding to said at least one product discount from said identified token data; and

generating a purchase incentive based on said discount items.

8. A method for distributing purchasing incentives to customers, said method comprising the steps of:

transmitting a prompt for identity data from a central

computer over a computer network to a personal computer;  
in response to said prompt, transmitting said identity data  
over said computer network to said central computer;  
transmitting an incentive offer over said computer network  
to said personal computer;  
transmitting incentive offer selection data over said  
computer network to said central computer; and  
in response to said selection data, transmitting data defining  
an incentive token over said computer network to said personal  
computer, wherein said incentive token is exercisable for said  
incentive at a store designated by said incentive offer, **further**  
**comprising transmitting terms of said purchasing incentive to**  
**an in-store server computer.**

As shown above, claim 32 omits the underlined portions of claim 8. However, one skilled in the art would have understood that these underlined portions or limitations are implicitly recited in claim 32. Further, this mailing address or identity data (including zip code) is part of the demographic data originally collected from the user during the initial encounter (user's first contact with the system) to decide, for example, whether or not the user lives in a qualified zip code, i.e. a zip code associated with a participating local store, before the user is allowed to receive and select product offers therefrom. In other words, before the user is allowed to select products from the system, as recited in claim 32, he must first provide his mailing address (at least his zip code) and this mailing address can be used at least to transmit the generated token, samples or marketing literature, to the user. It is further recognized, broadly interpreted, that the user's registration data are used, among other things, to create an ID or code or Password or identity data for the user and the user uses this cod [sic] (identity data) to log into the system and select coupon or product or incentive offers

therefrom.

Additionally, it is common practice to collect demographic information including mailing address from a user and use the collected information to send, via the Post Office, promotional information, such as coupons, to the user. Finally, using a password or identity data to log into a remote server or central computer is well documented in the art.

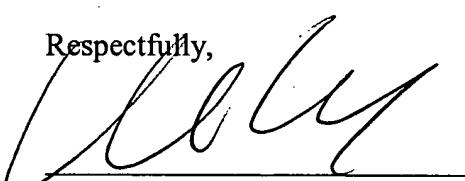
Therefore, an ordinary skilled artisan would have been motivated at the time of the invention to collect demographic information, including mailing address having a defined zip code, from the user during a registration process and use the collected data to decide whether the user lives in a qualified zip code, to generate a code (identity data) or password for the user and to mail, subsequent to this determination, a product coupon or a generated token having encoded thereon the user's product offer selections made online at the main computer using his generated password or code or identity data to log into the main computer.

Here, Applicant can amend the conflicting claims of the Instant Application or file a Terminal Disclaimer to overcome the Obviousness Double Patenting Rejection. [Office action mailed June 29, 2005 page 4 line 19 through page 10 line 11.]

In response, the applicant submits herewith two terminal disclaimers to overcome the two obviousness-type double patenting rejections over claims in application 09/478, 351 and patent 6,185, 541, respectively.

9/16/05

Date

Respectfully,  


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BTM

Printed: September 16, 2005 (2:46pm)

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